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MD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/749,721	11/15/96	MCGREGOR	D 12765

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LM01/0217

EXAMINER

GESESSE, T

ART UNIT

PAPER NUMBER

2746

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DATE MAILED: 02/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/749,721

Applicant(s)
McGregor

Examiner
Tilahun, Gesesse

Group Art Unit
2746



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above, claim(s) 13, 15, and 17 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-12, 14, 16, and 18-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 through 28 are rejected under the judicially created doctrine of double patenting over claims 1-32 of U. S. Patent No. 5,577,100 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as

follows: as in the patent No.5,577,100 in claim 1, the phone unit includes a processor, a clock, *specific program*

means and momory associated, ~~and claimed in the application, as claims 6 and 7 the same claim is repeated in the application,~~ which already patented in pat.no 5,577,100.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

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which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Allowable Subject Matter

3. Claims 1-12,14,16 and 18-28 are allowed.
4. The following is a statement of reasons for the indication of allowable subject matter: the feature of in a debit phone system with a system provider having a host processor that maintains accounts for use of mobile phone units, a mobile phone unit with internal accounting for use in a phone network wherein the mobile phone unit is a unitary hand-held device that internally calculates call charges and decrements call charges from a debit account, the mobile phone unit comprising: communication means in the mobile phone unit for wireless communication in the phone network; internal processing means in the mobile phone unit including a processor , a clock and memory for processing calls and call charges; program means retained in the memory of the mobile phone unit including rate data and a complex billing algorithm with a multiple factor accounting protocol for classifying calls according to the basic categories of local calls, long distance calls , international calls and roaming calls , applying a call rate according to category, and calculating call charges as calls are made, the program means further including internal accounting means for generating an internal debit account in the phone unit, wherein the phone unit has means for communicating with the system provider and adding an authorized amount to the debit account; wherein the mobile phone unit internally calculates call charges and decrements

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the calculated call charges from the amount in the debit account in the mobile phone unit as calls are made and wherein the mobile phone unit includes phone unit identification means for verification by the system provider using the host processor that a phone use account amount addable to the debit account of the identified phone unit has been prepaid; and, locking means for preventing calls from the phone unit when the amount in the debit account is exhausted, was not found nor fairly suggested in the prior art.

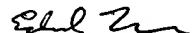
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun Gesesse whose telephone number is (703) 308-5873. The examiner can normally be reached on Monday to Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 3059508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Tilahun Gesesse
02-05-99


EDWARD F. URBAN
PRIMARY EXAMINER